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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/026,580
Filing Date: December 19, 2001
Appellant(s): DANIELS ET AL.

Christopher J. Capelli
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 8/10/04.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

The rejection of Claims 1-11 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

6,156,988	Baker	12-2000
5,703,783	Allen et al	12-1997
6,003,902	Petkovsek	12-1999
4,800,506	Axelrod et al	1-1989
5,832,504	Tripathi et al	11-1998

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baker (US 6,156,988). Baker discloses the following.

As described in Claims 1, 2 and 8;

a. a mail sorting apparatus (35 and 43);

b. printing identifyer (3) with information on an *unaddressed* employee mailpiece using a printer situated along a feedpath of a mail sorting apparatus, the employee information obtained from at least one database of the mail sorting apparatus (see figure 1);

c. delivering the employee mailpiece to a destination bin designated by destination bin information stored in the at least one database of the mail sorting apparatus (See figure 2, element (37);

d. placing *unaddressed* employee mailpieces on the incoming mail sorting apparatus (see feeder (21));

e. singulating an *unaddressed* employee mailpiece from the group of employee mailpieces and feeding the employee mailpiece along a feedpath of the incoming mail sorting apparatus (see figure 2, noting destination manager (29));

As described in Claims 3 and 8;

f. repeating the process until all mailpieces have been delivered (note that the system of Baker repeats until all mailpieces are sorted);

Baker sets forth that identifier/address (3) may be added to the envelope (1) at some point after one or more of the destination slots (9) are filled out. Although the identifier (3) is used to indicate the mail carrier (see col. 2, lines 30-39) this is printed on the envelope. It is noted that the carrier information indicates which bin or addressee the mailpiece goes to.

Therefore, it would have been obvious to one of ordinary skill in the art to have used the system of Baker to print the employee address on the envelope so that the mail can be delivered to the correct employee.

Baker further describes the following.

As described in Claims 4 and 8;

g. generating a report indicating a number of employee mailpieces printed and delivered and a cost associated with printing and delivering the employee mailpieces from the group of employee mailpieces;

As described in Claims 5 and 9;

h. the employee information includes employee name and delivery code information (see figure 1);

As described in Claims 6 and 10;

i. the employee information includes a message to the employee (note that the information depicted in figure 1 describes room for location and name, which is, in essence, a message to an employee);

As described in Claims 7 and 11;

j. the employee information includes a clip art figure (note that the information includes a bar code, which can be considered a form of clip art);

3. Claims 1-3 and 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allen et al (US 5,703,783). Allen et al discloses the following.

As described in Claims 1 and 2;

a. a mail sorting apparatus (96);

b. printing employee *address* (62, 142 and 144) information on an *unaddressed* employee mailpiece using a printer (94 and 112) situated along a feedpath of a mail sorting apparatus, the employee information obtained from at least one database (132) of the mail sorting apparatus (see figure 9);

c. delivering the employee mailpiece to a destination bin (98 or 116) designated by destination bin information stored in the at least one database of the mail sorting apparatus (See figure 6);

d. placing *unaddressed* employee mailpieces on the incoming mail sorting apparatus (80);

e. singulating an unaddressed employee mailpiece from the group of employee mailpieces and feeding the employee mailpiece along a feedpath of the incoming mail sorting apparatus (see figure 6);

As described in Claims 3;

f. repeating the process until all mailpieces have been delivered (note that the system of Allen repeats until all mailpieces are sorted);

As described in Claims 5;

g. the employee information includes employee name and delivery code information (see figure 3, noting that all mail has name and zip code);

As described in Claims 6;

h. the employee information includes a message to the employee (note the cancellation mark and zip code conveys information to the employee);

As described in Claims 7;

i. the employee information includes a clip art figure (note, for example, that the cancellation mark (52) can constitute clip art figure, as an eagle appears to be illustrated, for example);

Allen sets forth that identifier/address (144) may be added to the envelope (44) according to the existing facing identification marks (FIM) found on the mailpiece. Alternatively, a bar code (144) may be placed on the mailpiece that provides forwarding information. See Col. 14, lines 8-14.

Therefore, it would have been obvious to one of ordinary skill in the art to have used the system of Allen to print the employee address on the envelope so that the mail can be delivered to the correct employee, as described in Claims 1-3 and 5-7.

Claims 4 and 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allen et al (US 5,703,783) in view of Petkovsek. Allen et al discloses the system

as described above. Allen et al does not expressly disclose, but Petkovsek discloses the following.

As described in Claims 4 and 8;

j. generating a report indicating a number of employee mailpieces printed and delivered and a cost associated with printing and delivering the employee mailpieces from the group of employee mailpieces (see figure 6 of Petkovsek, noting that payment mechanism (34) allows payment input and that it would, at the very least, be obvious to one ordinarily skilled in the art to have compiled such cost data and invoice paid data into a report using the computerized system of Allen et al);

Both Allen et al and Petkovsek are analogous art because they concern mailpiece sorting.

At the time of the invention, it would have been obvious to a person ordinarily skilled in the art to have used the payment system of Petkovsek to keep track of costs in the system of Allen et al.

The suggestion/motivation is to keep track of costs for a corporate internal user of a company or to keep track of costs for billing of a company by an outside concern.

Allen further discloses the following.

As described in Claims 9;

g. the employee information includes employee name and delivery code information (see figure 3, noting that all mail has name and zip code);

As described in Claims 10;

h. the employee information includes a message to the employee (note the cancellation mark and zip code conveys information to the employee);

As described in Claims 11;

i. the employee information includes a clip art figure (note, for example, that the cancellation mark (52) can constitute clip art figure, as an eagle appears to be illustrated, for example);

4. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Axelrod et al (US 4,800,506). Axelrod discloses the following.

As described in Claims 1, 2 and 8;

a. a mail sorting apparatus (10);

b. printing employee *address* (E1-E3, G1-G4, i2-i6) information on an *unaddressed* employee mailpiece using a printer (12, 20 and 200) situated along a feedpath of a mail sorting apparatus, the employee information obtained from at least one database of the mail sorting apparatus; (See col. 2, lines 62-68 and col. 2, lines 1-16, noting that the computer stores

this various information. Note also that employee mailstops are considered to be equivalent to postal zipcodes and street addresses.)

c. delivering the employee mailpiece to a destination bin designated by destination bin information stored in the at least one database of the mail sorting apparatus (see col. 20, lines 34-41);

d. placing *unaddressed* employee mailpieces on the incoming mail sorting apparatus (see figure 2a-2d and 3, illustrates sending printed letters to a letter stuffing module as well as sending the printed and stuffed envelopes with the letters to mailbag (270));

e. singulating an *unaddressed* employee mailpiece from the group of employee mailpieces and feeding the employee mailpiece along a feedpath of the incoming mail sorting apparatus (again, see figures 2a-d and 3);

As described in Claims 3 and 8;

f. repeating the process until all mailpieces have been delivered (note that the system of Axelrod repeats until all mailpieces are sorted);

Axelrod sets forth that identifier/address (E1-E3, G1-G4, i2-i6) are printed on envelopes E, G and i. See col. 5, line 53-col. 7, lines 56. Taking envelope i, for example, such information includes address information i2, which identifies where the envelope is to be sent. Such a destination would have been obvious to one ordinarily

skilled in the art to have been a bin as mail bins are used at the post office as well as post office boxes and mailboxes at home addresses, for example.

Therefore, it would have been obvious to one of ordinary skill in the art to have used the system of Axelrod to print the employee address on the envelope so that the mail can be delivered to the correct employee.

Axelrod further discloses the following.

As described in Claims 4 and 8;

g. generating a report indicating a number of employee mailpieces printed and delivered and a cost associated with printing and delivering the employee mailpieces from the group of employee mailpieces (see col. 18, lines 30-35 and 55-63);

As described in Claims 5 and 9;

h. the employee information includes employee name and delivery code information (again, note that employee information of this type is considered to be functionally equivalent to a name and address);

As described in Claims 6 and 10;

i. the employee information includes a message to the employee (see figures 1a-1i, which show various indicia and messages, which can be made to refer to any subject one ordinarily skilled in the art could reasonably be possessed to include);

As described in Claims 7 and 11;

j. the employee information includes a clip art figure (again, see figures 1a-1i and graphical information (F1), as well as col. 6, lines 15-24);

Axelrod does not expressly disclose use of a mail printing/generating apparatus for internal mail.

At the time of the invention, it would have been obvious to one ordinarily skilled in the art to have used the apparatus of Axelrod to mail items exclusively for use in an internal mail environment. Note that such an environment is substantially the same as that used for regular postal mail. The mailstops and room numbers, for example, used as interoffice or internal mail address destinations are functional equivalents of postal addresses and zipcodes used in the traditional postal system.

5. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tripathi et al (US 5,832,504). Tripathi discloses the following.

As described in Claims 1, 2 and 8;

a. a mail sorting apparatus (see figure 1);

b. printing employee *address* information on an *unaddressed* employee mailpiece using a printer situated along a feedpath of a mail sorting apparatus, the employee information obtained from at least one database of the mail sorting apparatus; (See col. 5, lines 12-21.)

c. delivering the employee mailpiece to a destination bin designated by destination bin information stored in the at least one database of the mail sorting apparatus (see col. 5, lines 12-21, noting that the term "sorting" implies direction to a bin or destination based on various appropriate information);

d. placing *unaddressed* employee mailpieces on the incoming mail sorting apparatus (again, see col. 5, lines 12-21);

e. singulating an *unaddressed* employee mailpiece from the group of employee mailpieces and feeding the employee mailpiece along a feedpath of the incoming mail sorting apparatus (note that the printer and sorter have a feedpath);

As described in Claims 3 and 8;

f. repeating the process until all mailpieces have been delivered (note that the system of Tripathi repeats until all mailpieces are sorted);

Tripathi does not expressly disclose use of mail sorting apparatus for internal mail.

At the time of the invention, it would have been obvious to one ordinarily skilled in the art to have used the apparatus of Tripathi to sort mail items and place them into bins. This is suggested by Tripathi at col. 5, lines 12-21, which indicates that the items can be sorted before being mailed. Note also that sorting implies the segregation of mailpieces and their placing in a location or bin or the like for holding.

It also would have been obvious to one ordinarily skilled in the art to have used the apparatus of Tripathi to mail items exclusively for use in an internal mail environment. Note that such an environment is substantially the same as that used for regular postal mail. The mailstops and room numbers, for example, used as interoffice or internal mail address destinations are functional equivalents of postal addresses and zipcodes used in the traditional postal system.

Therefore, it would have been obvious to one of ordinary skill in the art to have used the system of Tripathi to print the employee address on the envelope so that the mail can be delivered to the correct employee.

As described in Claims 4 and 8;

g. generating a report indicating a number of employee mailpieces printed and delivered and a cost associated with printing and delivering the employee mailpieces from the group of employee mailpieces (see col.5 lines 55 and 56 and Col. 6, lines 1-30);

As described in Claims 5 and 9;

h. the employee information includes employee name and delivery code information (again, see col. 5, lines 12-21);

As described in Claims 6 and 10;

i. the employee information includes a message to the employee (again, see col. 5, lines 12-21);

As described in Claims 7 and 11;

j. the employee information includes a clip art figure (see col. 6, lines 26-29);

(11) Response to Arguments

Applicant asserts that the cited prior art does not read on Applicant's independent claims. However, as shown above, this is not the case.

It should be noted that Applicant has asserted that all claims stand or fall together. Therefore, Independent Claim 1 can be considered as representative of Independent Claims 2 and 8 as well as the other dependent claims. Therefore, it is posited that the limitations recited in element "b", as found on p.5, lines 3 and 4 of the Appeal Brief, are not to be considered because they are not found in Claim 1. Nonetheless, such limitations will be treated in the following discussion. Additionally, note that Applicant argues other limitations on p. 5, lines 9-15 of the brief that are not recited in the Claims, Claim 1, again being representative. Claim 1 does not recite "individually address[ing] each mailpiece in a generic mail distribution for intended employees wherein the mailpieces are initially presented to the sorter apparatus devoid of any employee addressing information..." Also, "maximiz[ing] the efficiency for the ensuing internal mail distribution, thus significantly improving the efficiency of the interoffice mail distribution" is not recited in Claim 1 as well.

Applicant asserts that Baker "teaches away from using a sorting apparatus for 'printing the employee information on an unaddressed employee mailpiece'..." Applicant's Claim 1 only requires that the printer is "situated along a feedpath" and not using the sorting apparatus to print.

Nonetheless, Applicant's claims, as currently written, may be reasonably construed to include the interpretation that Baker's bar code (3), which includes the mail carrier, is printed on the envelope. Additionally, it would have been obvious to one ordinarily skilled in the art to bar code any of the information on the front of the envelope so as to make the processing of the envelope information more efficient. Such does not render Baker's apparatus inoperable, but instead, is suggested by the use of bar code (3). In fact, a wide variety of techniques for representing information in machine-readable format is disclosed as capable of being used with Baker's system. See col. 2, lines 28-39. Note also that the characters printed on the spaces on Baker's envelope are read by character recognition software/hardware (31) (OCR). Such (OCR) equipment is also capable of reading bar codes

Regarding Allen, Applicant argues that the envelopes of Allen must be addressed first before placing it in the sorting address. However, Allen still performs the process of Applicant's claims. Allen discloses using a printer (94 and 112) situated along a feedpath of a mail sorting apparatus, as described above, said printer being a bar code printer that prints bar codes such as (62, 142 and 144). These bar codes can be construed to have address information, or a functional equivalent thereof. For example, Allen states in col. 5, lines 33-35 that bar code (62) contains "POSTNET" destination information. Bar codes (142 and 144) contain further address information. See col. 14, lines 8-14.

New forwarding address information is printed on Allen's envelopes. The fact prior address information is printed on said envelopes does not matter, since the Claim

language is literally met by Allen's disclosure, as described above. As described above, Petlkovsek is used primarily for its teachings of report generation, rather than for teaching printing on an unaddressed mailpiece. As previously described, Allen is considered to meet the limitations of the independent claims regarding printing on unaddressed mailpieces.

Regarding Axelrod, Applicant asserts that this system differs from Applicant's because it is preparing mailpieces by generating new mailpieces from scratch. The incoming mail sorting apparatus of Applicant is asserted to sort mailpieces already prepared and generated. If the mailpieces of Applicant's system are already generated, then this implies that there must be some identifier on the envelope that provides information to the system as to where it is going. Axelrod provides all of this information, even if it is generated from scratch, since an address can be construed to be a "bin identifier". Again, as described in the final action, above, the disclosure of Axelrod literally meets the limitations of Applicant's independent claims.

Regarding Tripathi, Applicant is correct that Tripathi discloses software that generates a report. However, note also that the environment and disclosure provides, at the very least, suggestion of Applicant's claim limitations. For example, in figure 2, step no. 35, document destination is mentioned as well as postal bar code, mailbox sorting (i.e., bin) as well as zip code sorting. Additionally, col. 5, lines 12-21 more specifically suggests and discusses use of such sorting devices. In fact, in lines 16-17, "bar coding and sorting before being mailed" is described. The system of Tripathi does

not exist in a vacuum, but instead, is used in the mail sorting environment described by Applicant's claims. Therefore, Tripathi meets Applicants claims as described above.

Therefore, it is suggested that the rejection of Applicant's Claims 1-11 be maintained.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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November 18, 2004

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